

### REMARKS

Reconsideration of this application and the rejection of claims 1-19 is respectfully requested. Applicants have attempted to address every objection and ground of rejection in the Office Action dated March 2, 2004 (Paper No. 6) and believe the application is now in condition for allowance or in better form for appeal. The claims have been amended to more clearly describe the present invention.

Applicants repeat their initial request regarding the Information Disclosure Statement filed July 28, 2003, which was cited to be deficient for lacking an explanation of the relevance of the non-English references, a copy of the relevant UK Search Report stating the relevance of the references accompanied the Statement. Consequently, pursuant to MPEP 609 III A(3), the non-English references should have been considered by the Examiner. Confirmation of their consideration is requested for a second time.

Claim 3 stands rejected under 35 U.S.C § 112 for rereciting the applicator pad previously recited in claim 1. By amendment, the duplicate language has been removed and the rejection is respectfully traversed.

Claims 1, 6, 11, 12 13 stand rejected under 35 U.S.C § 102(b) as being anticipated by Grossi et al. (US 2,787,998). Grossi teaches an electrically heated, vibratory medicament applicator having a saturated absorbent applicator pad for applying the medication. Medication is applied by pressing the unit upon the skin. In Grossi, the housing does not contact the skin. Instead, the porous membrane 164 is attached to the housing. Further, there is no direct heating of the skin as now recited.

As amended, claim 1 includes features of canceled claim 16 and recites, among other things, a housing enclosing a pump and a massage liquid reservoir located within said housing, said pump being in fluid communication with said reservoir and being provided with manual volume control of the dispensed massaging liquid. Also, in the present invention, heat is directly applied by the body-contacting portion of the housing to the target body surface and to the emitted liquid. In view of the failure of Grossi to suggest or disclose such structure, the rejection based on Grossi is respectfully traversed.

Claims 3, 4, 14 and 15 stand rejected in view of a combination of Grossi and McGrath (US 3,754,548). The arguments asserted above traversing Grossi are reasserted here. Grossi, whether taken alone or in combination with McGrath, fails to disclose or suggest a pump for emitting the massaging liquid as recited above, among other things. Also, Applicants submit that there is no incentive to combine the teachings of Grossi and McGrath. One look at FIG. 1 of Grossi depicting a housing filled with components clearly shows there is no way to incorporate a reservoir without extensive modification. Further, there is no incentive to incorporate a reservoir in Grossi, since the pad is absorbent and obviously held a desired amount of medicament. Further, regarding claims 14 and 15, even if the teachings of McGrath and Grossi could be combined, which Applicants dispute, the invention as now recited would neither be disclosed nor suggested.

First of all, McGrath's reservoir is clipped onto the housing (Col. 2, lines 40-45) and as such is not located within the housing as recited in amended claim 1. Second, McGrath fails to disclose or suggest the claimed pivoting reservoir mount of claim 14. The

clear language recites that the mount pivots. There is no such structure in McGrath, as admitted by the Examiner in his comparison of static hooks. Even if McGrath could be combined with Grossi, the claimed structure is lacking. The clear recitation of the present claims cannot be ignored.

Regarding claim 15, neither reference discloses or suggests a reservoir cover on the housing. Instead, McGrath's reservoir clips onto the outside of the housing as indicated above. In addition, the particular pivoting action of the present invention as recited in claim 15 is lacking in both references, particularly since McGrath lacks the pivoting reservoir mount of claim 14 and as such cannot achieve the recited pivoting action. Applicants note that Grossi issued in 1957 and McGrath in 1973. The Examiner has been unable to find a reference where such teachings were combined for the last 30 years. Surely if there was some incentive to combine these references, it would have been acted upon if it were so obvious. In view of the lack in the cited references of the structure now recited in amended claims 1, 14 and 15, the rejection based on a combination of Grossi and McGrath is respectfully traversed.

Claims 5, 7-9 stand rejected under 35 U.S.C. §103(a) in view of a combination of Grossi and Kieffer et al. The arguments asserted above traversing Grossi are reasserted here. Even if Kieffer does disclose a control for temperature and vibration, neither Kieffer nor Grossi, taken alone or in combination, disclose or suggest the invention as now recited in amended claim 1, and including among other things, a hand-held massager with a pump, a reservoir located within the housing and manual control over the emitted massaging liquid.

Accordingly, the rejection based on a combination of Grossi and Kiefer is respectfully traversed.

Claim 10 stands rejected under 35 U.S.C. § 103(a) in view of a combination of Grossi in view of Cheng. The arguments asserted above traversing Grossi are reasserted here. Even if Cheng does disclose the shock absorbing bolts as Examiner suggests, neither Cheng nor Grossi, taken alone or in combination, disclose or suggest the invention as now recited in amended claim 1, and including among other things, a hand-held massager with a pump, a reservoir located within the housing and manual control over the emitted massaging liquid. Accordingly, the rejection based on a combination of Grossi and Cheng is respectfully traversed.

Claims 16 and 17 stand rejected under 35 U.S.C. § 103(a) as being obvious in view of a combination of Grossi, McGrath and Bacher. The arguments asserted above traversing the rejection based on a combination of Grossi and McGrath are reasserted here. Claim 16 has been canceled and features thereof incorporated into claim 1. Bacher, circa 1942, discloses a device in which a supply of massaging cream is heated **prior** to being applied to rollers for application upon the skin. This is in clear contrast to the invention as recited in claim 1, in which the heat is applied by the housing **directly** to the skin and to the emitted lotion.

Applicants submit that there is no incentive to combine Bacher and Grossi. Bacher lacks any vibratory capability. Grossi's source of vibration is far within the housing and not constructed to generate vibrations on a body-contacting portion of the housing as

now recited. There is no such structure in Grossi. The vibrations are transmitted through a layer of asbestos, a heating pad, then a liquid filled sac 161, an absorbent medicament pad 163 and finally a porous membrane 164. Grossi already heats the pad, which heats the liquid filled container beneath it and eventually the medicament in the absorbent pad. Thus, a supplemental lotion or medicament heater as described by Bacher would be redundant. Also, tremendous redesign would be required to incorporate the heated massage balls of Bacher into the complicated cushion pad, medication pad and overlying porous membrane of Grossi to the point that one skilled in the art would be discouraged from making such a combination, rather than receiving an incentive to make anything like the claimed invention. As described above, Grossi's housing is filled with components, and without significant redesign, could not accommodate the lotion applicator of Bacher.

The Examiner is reminded that the present device is recited as being handheld, and as such there is a limit to what can be fit within the housing and still provide a practical device for handheld use. Grossi, the main reference is 47 years old and the secondary reference is 62 years old. Applicants are well aware that old references can be applied in rejections, but the point here is whether there is an **incentive to combine**. Applicants respectfully assert that there is no such incentive here, both in view of the basic disclosures of these references as well as their age. Applicants' claimed invention combines, among other things, direct heat by the massager housing, emission of the massing liquid before same is heated and vibration emitted by the body contacting portion of the

housing, all together in a hand held unit. Accordingly, the rejection based on a combination of Grossi and Bacher is respectfully traversed.

Claims 18 and 19 stand rejected under 35 U.S.C. §103(a) in view of a combination of Sivan and Kiefer et al. The arguments asserted previously against this combination are reasserted here. In addition, the Examiner has evidently completely ignored the language “a refill position in which said body-contacting portion is placed in a generally vertical position and said reservoir is in a generally parallel position relative to said body-contacting portion” found in original claim 18. There is no disclosure or suggestion in Sivan or Kiefer of such an orientation. To further emphasize this previously identified distinction, claim 18 has been amended to further recite that the reservoir is generally parallel to a body-contacting surface of said body-contacting portion.

As stated previously, Sivan teaches away from the use of heat during massage by claiming that vacuum therapy, in conjunction with gel, is filling a void in the market for treating cellulite, a market that already contains heated massagers. Assuming *arguendo* that Kiefer and Sivan share some common goals of skin treatment, the apparatus provided to accomplish such goals in the respective references is sufficiently different to teach away from a combination as asserted by the Examiner. Even if such a combination were made, the clear language of the claim is not met by either reference. Therefore, the rejection of claim 18 based on the combination of Kiefer and Sivan is respectfully traversed. Accordingly, claim 18 is submitted to be allowable.

Applicants respectfully reassert that the § 103(a) rejections asserted by the Examiner evidence "picking and choosing" features of the references and combining them when there is no suggestion in those references to do so. It is impermissible within the framework of a 35 U.S.C. § 103 rejection to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggest to one skilled in the art. Furthermore, obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination.

As stated above, the Examiner has made combinations, namely Grossi respectively with McGrath, Kiefer, and Bacher, as well as Kiefer and Sivan by grossly oversimplifying the act of combination without any evident consideration to the technical problems associated with the combination, especially in view of the particular focus of the respective references. In addition, the Examiner has ignored clear recitation of claim language in making the rejections.

Applicants submit that in view of the above-identified amendments and remarks, the claims in their present form are patentably distinct over the art of record. Allowance of the rejected claims is respectfully requested. In the alternative, the application is submitted to be in better form for appeal. Should the Examiner discover there are

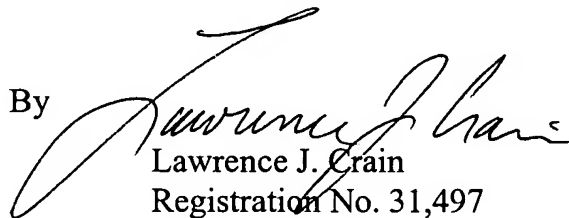
Appl. No. 10/037,964  
Amdt. Dated June 1, 2004  
Reply to Office Action of March 2, 2004

remaining issues which may be resolved by a telephone interview, an invitation is extended to contact Applicants' undersigned attorney at the telephone number listed below.

Respectfully submitted,

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